



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No. 5333**
Karl RODEMER et al. : Docket No. 2004-0479
Serial No. 10/808,415 : Group Art Unit 3682
Filed March 25, 2004 : Examiner Julie K. Smith
LUBRICATION DEVICE :

THE COMMISSIONER IS AUTHORIZED
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ACCOUNT NO. 23-0975.

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In view of the following remarks, reconsideration of the rejections contained in the Office Action of July 28, 2004 is respectfully requested.

Claims 1-23 are presently pending in this application. In the outstanding Office Action, the Examiner rejected all of the pending claims under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,742,625 (the '625 Patent). However, for the reasons set forth below, the Applicants respectfully submit that the double patenting rejection is improper and should be withdrawn.

As indicated on page 1 of the specification of this application, the present application is a divisional application based on parent application 09/950,080 ("the parent application"), which issued as the '625 Patent on June 1, 2004. A species restriction requirement was set forth in the parent application on March 12, 2003, in which the Examiner indicated that the parent application contains three patentably distinct species. Specifically, the Examiner enumerated Species I, directed to the species shown in Figures 1-2; Species II, directed to the species shown in Figures 3A-3D; and Species III, directed to the species shown in Figure 4. In response to the Examiner's Restriction

Requirement, the Applicants elected Species I on June 10, 2003, and indicated that claims 1-9 and 11-15 read on the elected species.

Subsequently, the present divisional application was filed on March 25, 2004, in order to present claims directed to the non-elected species enumerated in the Examiner's Restriction Requirement of March 12, 2003. In particular, independent claim 1 (the only presently-pending independent claim) of the present application corresponds to original non-elected independent claim 10 of the present application, and recites subject matter that reads on non-elected Species II of the Examiner's Restriction Requirement in the parent application.

The appropriate section of the U.S. code related to patents and which provides a basis for divisional applications, 35 USC § 121, explains that:

“a patent issuing on an application with respect to which a requirement for restriction under this section has been made . . . *shall not be used as a reference* either in the Patent and Trademark Office or in the courts *against a divisional application* . . . if the divisional application is filed before the issuance of the patent on the other application” (emphasis added).

As explained above, the present divisional application was filed in view of the Restriction Requirement set forth in the parent application, and was filed before the parent application issued as the '625 Patent. In other words, the present divisional application was filed in order to pursue subject matter withdrawn from consideration in the parent application in view of the Examiner's Restriction Requirement of March 12, 2003. Therefore, in view of the above-quoted portion of 35 USC § 121, it is submitted that the Examiner's double patenting rejection set forth in the outstanding Office Action is improper. Accordingly, the Examiner is respectfully requested to withdraw the double patenting rejection.

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance. However, if the Examiner should have any comments or suggestions to help speed the prosecution of this application, the Examiner is requested to contact the Applicant's undersigned representative.

Respectfully submitted,

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